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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,649	11/07/2001	Nobuyoshi Morimoto	5596-00901	9861

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EXAMINER
RAPILLO, KRISTINE K

ART UNIT	PAPER NUMBER
3626	

MAIL DATE	DELIVERY MODE
12/07/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/045,649	MORIMOTO, NOBUYOSHI
	Examiner	Art Unit	
	KRISTINE K. RAPILLO	3626	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>14 July 2009</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>7/14/2009</u> is/are: a)☒ accepted or b)☒ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date <u>2/11/2002; 6/25/2002; 1/13/2003; 1/21/2003;</u>
<u>8/18/2003; 12/16/2003; 2/5/2004</u>.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1.   This communication is in response to the amendment filed July 14, 2009. Claims 1, 12 – 15, and

19 – 20 are amended. Claims 1 - 20 are pending.

Drawings

2.   The objections to the drawings are hereby withdrawn based upon the amendment submitted July

14, 2009.

Claim Rejections - 35 USC § 112

3.   The 35 U.S.C. 112, second paragraph objections to claims 1 – 18 are hereby withdrawn based

upon the amendment submitted July 14, 2009.

Claim Rejections - 35 USC § 101

4.   The 35 U.S.C. 101 rejections of claims 1 - 18 are hereby withdrawn based upon the amendment

submitted July 14, 2009.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1 – 2, 5, 7 – 8, 12 – 15 and 19 - 20 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Harrell et al., herein after Harrell (U.S. Publication Number 2002/0156656 A1) in view

of www.pipinsure.com, herein after pipinsure

(http://web.archive.org/web/20000619183651/http://www.pipinsure.com/welcome.html), further in view of

Keuper (DE 44 46 203 A1; see English translation).

       In regard to claim 1 (Currently amended), Harrell teaches a method for arranging insurance for an

item to be shipped from an origination to a final destination, wherein the method comprises:

       Performing via one or more computers (Table 1):

       receiving a request, wherein the request is a request to insure the item during shipment from the

origination to the final destination (Figures 2 and 9; paragraphs [0005], [0031], [0041], and [0043]) where

high risk ports (destination) are taken into consideration when requesting and generating a quote for

insurance);

       generating a data file (Figure 1) comprising at least the following:

          item information including one or more characteristics of the item (paragraph [0043])

          where data is input regarding the commodity (i.e. item) and Table 9 discloses various

          characteristics of the item, such as the type of commodity; and

          insurer information indicating one or more terms of said particular insurance (Figures 2,

          4, and 5; paragraph [0048]; and, Tables 3, 4, 9, and 10); and

       storing the data file in a memory device (Figure1). Figure 1 illustrates the process for requesting

and generating a quote, including "stored data" which is equated to a data file.

       Pipinsure teaches a method comprising searching a database to select particular insurance for

the item, according to one or more insurance criteria, wherein the particular insurance provides a

specified level of insurance coverage for the item during said shipment (page 2 and pages 8 - 9) where

the user may input information to obtain a quote of various insurance products based on criteria input by

user (i.e. insured value of package, products shipped).

       Keuper teaches a method comprising a memory device (as taught by Harrell above) that

accompanies an item during said shipment (page 7, line 22 through page 8, line 3) where

       Therefore, it would have been obvious to a person of ordinary skill in the art at the time the

invention was made to include a method comprising a memory device that accompanies an item during

said shipment as taught by Keuper, within the method of Harrell and Pipinsure, with the motivation of acquiring shipment handling data on an item (abstract).

In regard to claim 2 (Original), Harrell, Pipinsure, and Keuper teach the method as recited in claim 1.

Keuper teaches a method wherein the memory device is configured to allow the data file to be updated at any time before, during or after the shipment (page 7, line 22 through page 8, line 3) where the data capable of being stored is also capable of being updated.

The motivation to combine the teachings of Harrell, Pipinsure, and Keuper is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 5 (Original), Harrell, Pipinsure, and Keuper teach the method as recited in claim 1. Harrell teaches a method further comprising forwarding copies of the data file via the network to one or more predetermined email addresses (paragraph [0041]).

In regard to claim 7 (Original), Harrell, Pipinsure, and Keuper teach the method as recited in claim 1. Harrell teaches a method further comprising shipping the item using the least expensive routing (Figure 2) where Harrell discloses modifications can determine the least expensive routing (i.e. lower premiums).

In regard to claim 8 (Previously Presented), Harrell, Pipinsure, and Keuper teach the method as recited in claim 1. Harrell further teaches a method wherein the data file further comprises contact information for at least one insurance companies that will provide said insurance (Figures 12 and 14) where Harrell discloses a reinsurer is notified in Figure 12, thus it is reasonable to conclude that the reinsurers contact information is available. In addition, Figure 14 illustrates contact of a claims representative and underwriter.

In regard to claim 12 (Currently Amended), Harrell, Pipinsure, and Keuper teach the method as recited in claim 1.

Keuper teaches a method wherein <u>the item information</u> data file further comprises item weight information (page 5, lines 7 - 11) where Keuper discloses that the weight information is documented using electronic identification.

The motivation to combine the teachings of Harrell, Pipinsure, and Keuper is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 13 (Currently Amended), Harrell and Vaghi teach the method as recited in claim 1.

Keuper teaches a method wherein <u>the item information</u> the data file further comprises item handling information (page 9, lines 21 - 22) where Keuper discloses that proper handing procedures are documented in a transponder.

The motivation to combine the teachings of Harrell, Pipinsure, and Keuper is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 14 (Currently Amended), Harrell, Pipinsure, and Keuper teach the method as recited in claim 1. Harrell teaches a method wherein <u>the item information</u> the data file further comprises item content information (paragraph [0043]) where content is equated to commodity.

In regard to claim 15 (Currently Amended), Harrell and Vaghi teach the method as recited in claim 1. Harrell teaches a method wherein <u>the insurer information in</u> the data file further comprises <u>one or more of: an insurance carrier that provides the particular insurance, an insurance policy number that identifies the particular insurance, an amount of insurance provided by the particular insurance, and an</u>

insure deductible for the particular insurance (paragraph [0043]) where the file contains the amount

insured (i.e. insurance information).

System and storage claims 19 and 20 repeat the subject matter of claims 1, 2, and 6. As the

underlying processes of claims 1, 2, and 6 have been shown to be fully disclosed by the teachings of

Harrell and Vaghi in the above rejections of claims 1, 2, and 6; as such, these limitations (19 and 20) are

rejected for the same reasons given above for claims 1, 2, and 6 and incorporated herein.

7.   Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harrell (U.S. Publication

Number 2002/0156656 A1) in view of www.pipinsure.com, herein after pipinsure

(http://web.archive.org/web/20000619183651/http://www.pipinsure.com/welcome.html), and Keuper (DE

44 46 203 A1; see English translation) further in view of Welles et al., herein after Welles (U.S. Patent

Number 5,686,888).

In regard to claim 3 (Original), Harrell, Pipinsure, and Keuper teach the method as recited in claim

1.

Welles teaches a method further comprising packing the item in a container for shipping, wherein

the container is configured to fit with multiple other containers in a carrier (column 6, lines 4 – 23) where

Welles discloses attaching a sensor to each piece of cargo within a container.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the

invention was made to include a method further comprising packing the item in a container for shipping,

wherein the container is configured to fit with multiple other containers in a carrier with the motivation of

monitoring the condition and/or integrity of good being shipped (abstract).

8.   Claims 4, 6, 9 – 11 and 16 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Harrell (U.S. Publication Number 2002/0156656 A1) in view of www.pipinsure.com, herein after pipinsure

(http://web.archive.org/web/20000619183651/http://www.pipinsure.com/welcome.html) and Keuper (DE

44 46 203 A1; see English translation) as applied to claim 1 above, and further in view of Bennett et al.,
herein after Bennett (U.S. Patent Number 7,117,170).

In regard to claim 4 (Original), Harrell, Pipinsure, and Keuper teach the method as recited in claim
1.

Bennett teaches a method further comprising forwarding copies of at least a portion of the data
file via the network to one or more of the parties involved in the shipping, wherein the parties include at
least an originator of the request to ship the item, a recipient of the item at the final destination, and at
least one insurance company (Figures 26, 28, and 29; column 8, lines 41 – 57; column 12, lines 47 – 65;
and, column 13, lines 16 - 42) where Bennett discloses origin and destination (via zip codes) and
communicating this information over the internet.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the
invention was made to include a method comprising forwarding copies of at least a portion of the data file
via the network to one or more of the parties involved in the shipping, wherein the parties include at least
an originator of the request to ship the item, a recipient of the item at the final destination, and at least
one insurance company as taught by Bennett, within the method of Harrell, Pipinsure, and Keuper, with
the motivation of providing the capability of tracking, storing, and transmitting the information over a
shipment carriers web server (column 55, lines 46 – 62)

In regard to claim 6 (Original), Harrell, Pipinsure, and Keuper teach the method as recited in claim
1.

 Bennett teaches a method further comprising forwarding a copy of the data file via a network to a
central server (column 8, lines 41 – 57; column 12, lines 47 – 65; and, column 13, lines 16 - 42) where a
server has access to one or more databases.

The motivation to combine the teachings of Harrell, Pipinsure, Keuper, and Bennett is discussed
in the rejection of claim 4, and incorporated herein.

In regard to claim 9 (Original), Harrell, Pipinsure, and Keuper teach the method as recited in claim 1.

Bennett teaches a method further comprising storing the data file on a server connected to a network, wherein the server provides access to the data file via the network (column 8, lines 41 – 57; column 12, lines 47 – 65; and, column 13, lines 16 - 42).

The motivation to combine the teachings of Harrell, Pipinsure, Keuper, and Bennett is discussed in the rejection of claim 4, and incorporated herein.

In regard to claim 10 (Previously Presented), Harrell, Pipinsure, and Keuper teach the method as recited in claim 1.

Bennett teaches a method wherein storing the data file comprises storing the data file in an XML format (Figures 66 and 67; column 11, lines 55 – 63; and column 55, lines 33 – 45).

The motivation to combine the teachings of Harrell, Pipinsure, Keuper, and Bennett is discussed in the rejection of claim 4, and incorporated herein.

In regard to claim 11 (Previously presented), Harrell, Pipinsure, and Keuper teach the method as recited in claim 9.

Bennett teaches a method wherein the network data is exchanged in an XML format (Figures 66 and 67; column 11, lines 55 – 63; and column 55, lines 33 – 45).

The motivation to combine the teachings of Harrell, Pipinsure, Keuper, and Bennett is discussed in the rejection of claim 4, and incorporated herein.

In regard to claim 16 (Original), Harrell, Pipinsure, and Keuper teach the method as recited in claim 1.

Bennett teaches a method wherein the data file further comprises one or more digital images of the item before, during, or after shipping (column 28, line 60 through column 29, line 10).

The motivation to combine the teachings of Harrell, Pipinsure, Keuper, and Bennett is discussed in the rejection of claim 4, and incorporated herein.

In regard to claim 17 (Original), Harrell, Pipinsure, and Keuper teach the method as recited in claim 1.

Bennett teaches a method wherein the data file further comprises one or more digital images of the item showing the physical condition of the item upon receipt (column 48, lines 43 – 57).

The motivation to combine the teachings of Harrell, Pipinsure, Keuper, and Bennett is discussed in the rejection of claim 4, and incorporated herein.

9.   Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harrell in view of www.pipinsure.com, herein after pipinsure (http://web.archive.org/web/20000619183651/http://www.pipinsure.com/welcome.html) and Keuper (DE 44 46 203 A1; see English translation) as applied to claim 1 above, and further in view of Kepler (U.S. Patent Number 5,347,845).

In regard to claim 18 (Original), Harrell, Pipinsure, and Keuper teach the method as recited in claim 1.

Kepler teaches a method wherein the memory device comprises an air testing device configured to test air samples for contaminants and to store test results in the data file (column 2, lines 25 - 35).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method wherein the memory device comprises an air testing device configured to test air samples for contaminants and to store test results in the data file as taught by Kepler, within the method of Harrell, Pipinsure, and Keuper, with the motivation of detecting the presence of contaminants in shipping containers (Abstract).

Response to Arguments

10.   Applicant's arguments filed July 14, 2009 have been fully considered but they are not persuasive.

Eligibility of Harrell as a Prior Art Reference

The Applicant notes that Harrell was filed after the priority date established by Applicant's provisional application, but does claim the benefit of a provisional application filed August 29, 2000. The Examiner respectfully submits the provisional application of Harrell, as well as a table correlating the appropriate paragraphs of the provisional and non-provisional application; the table has been appended to the provisional application for ease of the Applicant's review.

35 U.S.C. 103(a) Rejections

With regard to claim 1, it is respectfully submitted that the Examiner has applied new prior art to the amended claims. The Examiner notes that the amended limitations were not in the previously pending claims; as such, Applicant's remarks with the regard to the application of Harrell and Vaghi are moot.

With regard to claims 19 and 20, the Applicant argues the Office Action failed to state a prima facie rejection of claims 19 and 20 because the Office Action failed to address specific limitations of 19 and 20. The Examiner notes that the amended limitations were not in the previously pending claims; as such, the Examiner has applied new prior art to the amended claims; thus, the Applicant's remarks with the regard to the prima facie rejection of claims 19 and 20 is moot.

Conclusion

11.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTINE K. RAPILLO whose telephone number is (571)270-3325. The examiner can normally be reached on Monday to Thursday 6:30 am to 4 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KKR

/Robert Morgan/
Primary Examiner, Art Unit 3626